

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

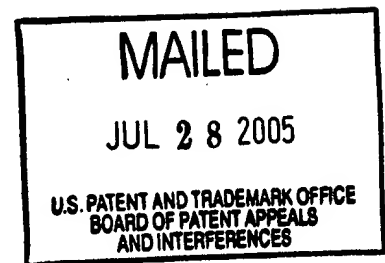
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte DANIEL P. KELLY

Appeal No. 2005-1416
Application No. 09/771,782

ON BRIEF



Before GARRIS, PAK, and JEFFREY T. SMITH, Administrative Patent Judges.
JEFFREY T. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 37 to
43 and 47 to 49, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to methods of making necklaces. (Specification,

p. 1). Representative claim 37 appears below:

37. A method of making necklaces, comprising the steps of:
providing a mold of sports projectile shaped beads for a necklace;
placing a string or other line or cord in the mold;
supplying plastic to the mold;
removing from the mold a necklace formed of sports projectile shaped
beads direct-molded onto the string or other line or cord.

In addition to the prior art discussed in the specification, the Examiner relies on the following reference in rejecting the appealed claims are:

Bateholts	1,958,841	May 15, 1934
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Claims 37-43 and 47-49 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bateholts in view of the admitted prior art mentioned on page 1 of the present patent application. (Answer, pp. 5-15). We affirm the rejection.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellant regarding the above-noted rejection, we make reference to the Answer (mailed June 28, 2004) and the non-final office action mailed March 31, 2003 for the Examiner's reasoning in support of the rejection, and to the Brief (filed April 15, 2004) for the Appellant's arguments there against.

We initially note that Appellant asserts that for purposes of appeal that the claims do not stand or fall together. (Brief, p. 3). However, we find no separate arguments as to the separate claims as required by 37 CFR § 1.192(c)(7) (2004). Accordingly, all of the claims will stand or fall together and we select claim 37 as representative of the claims on appeal and limit our consideration thereto.

OPINION

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the Examiner and Appellant in support of their respective positions. This review has led us to conclude that the Examiner's § 103 rejections are well founded. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-1472, 223 USPQ 785, 787-788 (Fed. Cir. 1984).

The Examiner has determined, Office action mailed March 31, 2003, that Bateholts teaches the claimed method of making a necklace. (Bateholts, p. 1, ll. 1-10; figs 1-4). According to the Examiner, Bateholts discloses providing a mold of beads for a necklace wherein the beads can be spherical or cylindrical and placing a string or other line or cord in the mold. (Figs 1-4). The product produced by the method of Bateholts is a necklace formed of beads directly molded onto the string or line or cord. The Examiner asserted that Bateholts does not teach the beads as

having a sport projectile shape. The Examiner determined that the prior art disclosed in the specification describes necklaces having baseball or football beads, i.e., beads having a sport projectile shape. The Examiner concluded that it would have been obvious to a person of ordinary skill in the art to perform the method of making a necklace, disclosed by Bateholts, employing molds for beads in the shape of a sport projectile. (Office action mailed March 31, 2003, p. 3).

Appellant argues that the prior art discussed in the specification merely shows that some elements of the claimed invention are old and there is no suggestion to combine the references. (Brief, pp. 3-4).

We do not find Appellant's arguments persuasive. The Examiner finds, and Appellant does not specifically dispute, that a person of ordinary skill in the art would have been motivated to "combine or modify the teachings of Bateholts with the admitted prior of record is to produce diverse product lines of beaded necklaces, i.e., beaded necklaces with varying designs [inclusive of a sport projectile shape] which have appeal to a wide range of customers, and is found in knowledge generally available to one of ordinary skill in the art." (Answer, p. 3). The motivation for combining or modifying the teachings of the prior art to produce the claimed invention can be derived from either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. A person of ordinary skill in the art would have reasonably expected that the method described by Bateholts would

be useful for forming the shape of a sports projectile. "For obviousness under § 103, all that is required is a reasonable expectation of success." *In re O'Farrell*, 853 F.2d 894, 904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

In light of the foregoing and for the reasons expressed by the Examiner, it is our determination that the Examiner has established a *prima facie* case of obviousness with respect to the argued claims on appeal.

"Once a *prima facie* case of obviousness has been established, the burden shifts to the applicant to come forward with evidence of nonobviousness to overcome the *prima facie* case." *In re Huang*, 100 F.3d 135, 139, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996). As indicia of obviousness or nonobviousness, such secondary considerations as commercial success, long felt but unresolved needs, copying by others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented and, therefore, may be relevant to the question of obviousness or nonobviousness. *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966).

Appellant has presented several declarations as evidence of non-obviousness of the invention. Appellant states "[s]pecifically, the 31 October 2002 declaration is evidence of copying by others, the 23 January 2003 declaration is evidence of licensing by others and copying by others, the 29 January 2003 declaration is evidence of licensing to others, copying by others, and commercial success, and the

31 July 2003 declaration¹ is evidence of licensing to others, copying by others, and commercial success; all of these are indications of non-obviousness of the invention."² (Brief, pp. 4-5). Appellant also relies on the declaration filed 12 April 2004 for showing the sale of necklaces. (Brief, p. 5).

The Examiner has provided a discussion of the all of the declarations relied upon by Appellant in the Brief. (Answer, pp. 3-4).

"Evidence of secondary considerations are but a part of the 'totality of the evidence' that is used to reach the ultimate conclusion of obviousness."

Richardson-Vicks Inc. v. Upjohn Co., 122 F.3d 1476, 1483, 44 USPQ2d 1181, 1187 (Fed. Cir. 1997). The usefulness of this type of evidence lies in the fact that it "serves as a guard against slipping into hindsight" during the determination of obviousness, *Graham*, 383 U.S. at 17-18, in that it may demonstrate that the invention, while it appears to be obvious upon looking back in time with hindsight, really was not. *Stratoflex Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39, 218 USPQ 871, 879 (Fed. Cir. 1983). To properly consider secondary considerations, we must consider all of the evidence under the *Graham* factors together. *Id.*

¹ We note that the image of the declaration filed July 31, 2003, contained in the official electronic file does not have the signature of the declarant.

²All of the presented declarations have been presented by Daniel P. Kelly who is the sole inventor of the present application.

In weighing secondary considerations along with the other evidence, the secondary considerations must be carefully appraised as to evidentiary value. *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 908, 225 USPQ 20, 26 (Fed. Cir. 1985). In some cases, evidence of secondary considerations is highly probative on the question of obviousness. *Richardson-Vicks*, 122 F.3d at 1483, 44 USPQ2d at 1187. However, the existence of such evidence does not control the obviousness determination, it remains in the realm of secondary considerations. *Id.* A nexus between the merits of the claimed invention and the evidence of secondary considerations is required in order for the evidence to be given substantial weight in an obviousness decision. *Stratoflex*, 713 F.2d at 1539, 218 USPQ at 879.

Looking at the totality of the evidence, we conclude that the evidence of licensing to others, copying by others, and commercial success does not outweigh the evidence of obviousness. Here, claim 37, the sole independent claim, is directed to a method of making a necklace employing a mold of sports projectile shaped beads for a necklace. The declarations do not discuss the subject matter of the independent claim 37, specifically. The discussion of the copying of the invention by others and the licensing of the invention to others is not directed to the claimed method of making a necklace.³

³ Appellant has presented several declaration to discuss the various aspects of the secondary considerations. We will limit our discussion to a representative declaration for each of the discussed secondary consideration.

The declaration of July 31, 2004, discusses the copying of necklaces and losses resulting therefrom. The declaration does not indicate that the claimed method was in fact copied. The declaration does not specifically indicate that the copied necklace was manufactured by the claimed method. More importantly, the declaration does not indicate that there was widespread acceptance and adoption of the claimed method, much less the unclaimed necklace. See *Cable Electric Prods. v. Genmark, Inc.* 770 F.2d 1015, 1028, 226 U.S.P.Q. 881, 889 (Fed. Cir. 1985). ("more than the mere fact of copying by an accused infringer is needed to make that action significant to a determination of the obviousness issue."). Thus, Appellant has not demonstrated that there was widespread acceptance and adoption of the claimed invention and a nexus between the merits of the claimed method and the copying discussed in the declaration.

The declaration of October 31, 2002, discusses the licensing of a product to one company "Innovative Marketing" which sells necklaces. The declaration does not indicate that the claimed method was in fact licensed. The declaration does not detail what aspect(s) of the claimed invention was the subject of the licensing agreements. Thus, a nexus has not been shown for the claimed method and the licensing discussed in the declaration.

Regarding commercial success, Appellant has failed to prove that the sales were a direct result of the unique characteristics of the claimed invention. In other

words, Appellant has not established a nexus between the claimed method of making a necklace and the alleged commercial success. *Sandt Tech. Ltd. v. Resco Metal and Plastics Corp.*, 264 F.3d 1344, 1355, 60 USPQ2d 1091, 1098 (Fed. Cir. 2001). (There was no evidence that the better means of attachment improved the protective capacity of the phones, thereby spurring sales. In other words, nexus was not proven between this feature, which embodied the difference between the prior art and claimed invention, and the substantial sales). The declaration do not provide any factual basis to conclude that the alleged commercial success is due to the claimed method of making a necklace. The alleged commercial success could be due to other considerations, such as increased popularity of a sport or a sport franchise unrelated to the merits of the claimed method or the unclaimed necklace.

Further, Appellant has not established commercial success of the claimed method, much less the unclaimed necklace. To establish commercial success, there must be evidence regarding the market sector for the claimed invention and how much of the market sector is controlled by the claimed invention. However, the declaration does not identify the market size for the claimed invention or the unclaimed necklace and how much of the market was controlled by the claimed invention or the unclaimed necklace. The declarations presented on this record are devoid of information necessary to establish commercial success.

Based on our consideration of the totality of the record before us, having evaluated the *prima facie* case of obviousness in view of Appellant's arguments and evidence, we conclude that the subject matter of claims 37 to 43 and 47 to 49 would have been obvious to a person of ordinary skill in the art from the combined teachings of the cited prior art. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

CONCLUSION

For the foregoing reasons and those set forth in the Answer, we determine that the preponderance of evidence weighs in favor of obviousness, giving due weight to Appellant's arguments and evidence. Accordingly, the Examiner's rejection under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(iv)(effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).


BRADLEY R. GARRISS
Administrative Patent Judge


CHUNG K. PAK
Administrative Patent Judge


JEFFREY T. SMITH
Administrative Patent Judge

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